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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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04/17/2001

Harald Kaufmann

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COLLARD & ROE, P.C.  
1077 NORTHERN BOULEVARD  
ROSLYN, NY 11576

EXAMINER

ZIMMERMAN, JOSHUA D

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/807,774	<b>Applicant(s)</b> KAUFMANN, HARALD	
	<b>Examiner</b> JOSHUA D. ZIMMERMAN	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/26/08 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. Claims 28-36 and 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 28-36 and 38-40, the independent claims set forth in the preambles that the reflection transfer is manufactured and applied to a substrate. However, claims 29, 30 and 31 then recite the step of "forming the reflection transfer on said substrate." It is therefore unclear how the reflection transfer can be both manufactured prior to applying it to the substrate, and then formed on the substrate. For purposes of examination, the limitation "forming the reflection transfer on said substrate" will be ignored. Appropriate clarification and/or correction is required.

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3. Claims 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 38-41, applicant claims that the reflection ink layer forms a face opposite said open face to form a reflective surface on said substrate after said open face is applied to said substrate. However, since the parent claims (claims 28, 29, 30 and 37) require that the open face is applied to the substrate, the substrate must be the face opposite said open face. It is therefore unclear how the reflection ink layer can form a face which is opposite said open face. As it cannot be ascertained what Applicant is trying to claim, prior art could not be applied.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28-30, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (US 3172942) in view of Nellessen et al. (US 3420597).

Regarding claim 28, Berg teaches a "process for the manufacture of a reflection transfer and for applying the transfer to a substrate (title, column 7, lines 13-15) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying a transfer adhesive on the base medium, wherein the transfer adhesive is at least one of heat-sensitive and pressure sensitive (item 18);

applying an intermediate ink layer onto a side of said transfer adhesive opposite said base medium (item 17);

applying a reflection ink layer (items 12 and 16) comprising a plurality of reflection particles (item 14),

wherein said intermediate ink layer is not clear translucent (column 7, lines 21-33);

removing said adhesive repellent base medium to form an open face on said reflection transfer (column 7, lines 10-11);

applying said open face of said reflection transfer onto said substrate (column 7, lines 11-12).”

Berg fails to teach that the reflection ink layer is applied “directly onto said intermediate ink layer, wherein said reflection particles are added to the reflection ink before applying the reflection ink on the intermediate ink layer;

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an ink before applying to the substrate (column 3, lines 35-40);

screen printing the ink onto the substrate (column 5, lines 55-57); and  
drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claim 29, Berg teaches a “process for the manufacture of a reflection transfer and for applying the transfer to a substrate (title, column 7, lines 13-15) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying onto the base medium” a transfer film (item 13) comprising a transfer adhesive (item 16) and reflection particles (item 14)

wherein the “adhesive is not clear translucent (column 7, lines 29-31);

removing said adhesive repellent base medium to form an open face on said reflection transfer (column 7, lines 10-11); and

applying said open face of said reflection transfer onto said substrate (column 7, lines 11-12).”

Berg fails to teach:

that the adhesive layer contains the reflection particles,

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer.

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an adhesive before applying to the substrate (column 3, lines 35-40);

screen printing the ink onto the substrate (column 5, lines 55-57); and

drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claim 30, Berg teaches a "process for the manufacture of a reflection transfer and for applying the transfer to a substrate (title, column 7, lines 13-15) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying a transfer adhesive on the base medium, wherein the transfer adhesive is at least one of heat-sensitive and pressure sensitive (item 18);

applying a reflection ink layer (items 12 and 16) comprising a plurality of reflection particles (item 14),

wherein said transfer adhesive is not translucent (column 7, lines 21-33);

removing said adhesive repellent base medium to form an open face on said reflection transfer (column 7, lines 10-11); and

applying said open face of said reflection transfer onto said substrate (column 7, lines 11-12).”

Berg fails to teach that the reflection ink layer is applied “directly onto said transfer adhesive, wherein said reflection particles are added to the reflection ink before applying the reflection ink on the transfer adhesive; and

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an ink before applying to the substrate (column 3, lines 35-40); and

drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink



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application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claims 32 and 33, Berg further teaches “applying said reflection transfer to a substrate using a transfer press (column 7, lines 13-17).”

Regarding claims 34-36, Berg as modified meets all the claim limitations, as applied in claims 28-30 above, except that the process steps are in reverse order. However, Examiner notes that the resultant reflection transfer is identical to the *claimed* reflection transfer. Furthermore, it has been held that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. See MPEP §2144.04, IV(c). Therefore, since the resultant reflection transfer is identical to that which is instantly claimed, that is, there are no new or unexpected results, the order in which the process steps are performed is not deemed to patentably distinguish over the modified method of Berg.

Regarding claim 37, Berg teaches a “process for the manufacture of a reflection transfer and for applying the transfer to a substrate (title, column 7, lines 13-15) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying a transfer adhesive on the base medium, wherein the transfer adhesive is at least one of heat-sensitive and pressure sensitive (item 18);

applying an intermediate ink layer onto a side of said transfer adhesive opposite said base medium (item 17);

applying a reflection ink layer (items 12 and 16) comprising a plurality of reflection particles (item 14),

wherein said intermediate ink layer is not clear translucent (column 7, lines 21-33);

wherein said adhesive repellent base medium is configured to be removable to form an open face on said reflection transfer, said open face for application to a substrate (column 7, lines 10-12).”

Berg fails to teach that the reflection ink layer is applied “directly onto said intermediate ink layer, wherein said reflection particles are added to the reflection ink before applying the reflection ink on the intermediate ink layer;

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an ink before applying to the substrate (column 3, lines 35-40);

screen printing the ink onto the substrate (column 5, lines 55-57); and

drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (US 3172942) in view of Nellessen et al. (US 3420597), as applied to claim 30 above, further in view of Applicant's Admitted Prior Art (AAPA)

Regarding claim 31, Berg and Nellessen et al. teach all that is claimed but fail to further teach "applying said transfer adhesive via a screen print process." However, AAPA teaches using a screen print process in order to achieve a transfer system that can be manufactured in a simple manner, at a reasonable cost and in large numbers (page 3, lines 9-28 of applicant's specification). Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to use a screen print process in the modified method of Berg in order to achieve a transfer system that can be manufactured in a simple manner, at a reasonable cost, and in large numbers.

### ***Response to Arguments***

6. Applicant's arguments filed 03/26/09 have been fully considered but they are not persuasive.

Applicant's argument that none of the prior art shows the newly added feature: "removing said adhesive repellent base medium to form an open face on said reflection

transfer;

applying said open face of said reflection transfer onto said substrate”

is not understood because Berg teaches this, as stated in the rejection above, at column 7, lines 10-12.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the benefit of applying the transfer face up) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. ZIMMERMAN whose telephone number is (571)272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman  
Examiner  
Art Unit 2854

/jdz/